

REMARKS

This Reply and Amendment is intended to be completely responsive to the Non-Final Office Action dated August 1, 2003. Claims 1-88 are pending in this Application. Claims 1-31 and 37-65 stand rejected. Claims 32-36 and 65-74 are cancelled. Claims 75-88 are new. Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 10, 12, 19, 37, 42, 43, 44, 49, 58, and 65 are currently being amended. The claims are not amended in a limiting fashion and are amended to more clearly define the invention. No new matter is added.

New Claims 75-88 are being added. No new matter is added.

This reply and amendment adds, changes and/or deletes claims in this Application. A detailed listing of all claims that are, or were, in the Application, irrespective of whether the claim(s) remain under examination in the Application, is presented, with an appropriate defined status identifier.

**Election/Restriction**

In response to the restriction requirement set forth in section 1 of the Office Action, Applicants hereby elect Group I, Claims 1-31 and 37-65, for examination, with traverse.

The Office has required restriction between Claims 1-31 and 37-65 (Group I), drawn to a container (product), and Claims 32-36 and 66-74 (Group II), drawn to a method for producing the product. Applicants respectfully disagree and traverse the restriction requirement. However, in order to advance prosecution on the merits, the Applicants hereby elect Group I, Claims 1-31 and 37-65, for examination and cancel Claims 32-36 and 66-74 without prejudice. In doing so, the Applicants reserve the right to file any divisional Applications based on the elected and/or non-elected portions of the present Application. Further, the election of Group I (Claims 1-31

and 37-65), in response to the restriction requirement, is not a narrowing amendment and should not be interpreted to limit the scope of the pending claims or the range of permissible equivalents.

### **Drawings**

At section 2 of the Office Action, the drawings were objected to under 37 C.F.R. § 1.83(a). The Office Action states that “[t]he drawings must show every feature of the invention specified in the claims. Therefore, an embodiment showing, ‘three platforms,’ as claimed in claim 51, and, ‘at least two platforms with a supplemental platform,’ as claimed in claims 55-57, must be shown or the feature(s) canceled from the claim(s).”

Applicants have provided a proposed revision by including FIGURES 8A and 8B that comprise more than two platforms. No new matter has been added. The specification provides support for more than two platforms. See, e.g., paragraph 36 of the specification (explaining that the container may include a supplemental platform such as a three tiered configuration). Accordingly, Applicants request withdrawal of this objection.

### **Claims 1, 19, 37, 42, 43, 49, 58, 65**

Claims 1, 19, 37, 42, 43, 49, 58, 65 have been amended for clarity.

### **Claim Rejections – 35 U.S.C. § 112, first paragraph**

At section 3 of the Office Action, the Office states that “Claims 55-57 [are] rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” The substance of this rejection is that “[i]t is unclear how a supplemental platform would be added to the container.” See section 4 of the Office Action. The Office Action “notes there aren’t figures present for this embodiment, and the Specification does not enable any method of securing the supplemental platform within the base and cover.”

Applicants respectfully traverse the rejection because the disclosure provides support for more than two platforms. See, e.g., paragraph 36 of the specification. From the disclosure, a person skilled in the art would readily recognize: (1) a supplemental platform may be added to the container; (2) a supplemental platform may be secured to the container as disclosed elsewhere within the Application; and (3) new FIGURE 8 shows an embodiment of a container with a supplemental platform as described in the specification. See, e.g., paragraph 36 of the specification. However, these are only examples, and the configuration is not intended to be limited in scope by any exemplary embodiment.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection under 35 U.S.C. § 112, first paragraph.

**Claim Rejections – 35 U.S.C. § 112, second paragraph**

**Claims 11, 12 and 44**

At section 6 of the Office Action, the Office rejected Claims 11, 12 and 44 under 35 U.S.C. § 112, paragraph 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 10, 12 and 44 have been amended for clarity. Claim 11 depends from Claim 10 (as amended). Accordingly, the rejection of Claims 11, 12 and 44 under 35 U.S.C. § 112, paragraph 2 has been overcome.

**Claims 7, 8, 19-31, 37-41, 47 and 63**

At section 6 of the Office Action, the Office rejected Claims 7, 8, 19-31, 37-41, 47 and 63 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office asserted that it was unclear what was meant by the term “about.”

The Applicants respectfully traverse this assertion. According to MPEP § 2173.05(b), “the fact that claim language, including terms of degree, may not be precise, does not

automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph.” See Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 U.S.P.Q. 568 (Fed. Cir. 1984). MPEP § 2173.05(b) further states that “acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” Case law fully affirms the use of the term “about” in claims. For example, the term “about” used to define the area of a lower end of a mold as between 25 to about 45% of the mold entrance has been held to be clear, but flexible. Ex Parte Eastwood, 163 U.S.P.Q. 316 (Bd. App. 1968). In W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), a limitation defining the stretch rate of a plastic as “exceeding about 10% per second” was held to be definite because infringement could clearly be assessed through the use of a stopwatch.

Thus, the term “about” may be used as a relative term in Claims 7, 8, 19-31, 37-41, 47, and 63 since the limitations would be understood by a person skilled in the art. A person skilled in the art would be able to read Claim 7 and measure “about 120 degrees” in light of the specification. Accordingly, Applicants respectfully request withdrawal of the rejections of Claims 7, 8, 19-31, 37-41, 47 and 63 under 35 U.S.C. § 112, second paragraph.

#### **Claim 27**

At section 6 of the Office Action, the Office rejected Claim 27 under U.S.C. § 112, paragraph 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office asserted that “it is unclear what the metes and bounds of, ‘tacky,’ comprise.”

Applicants’ use of the term “tacky” is intended to reflect the common meaning of the term and is intended to have a clear meaning in harmony with the commonly understood general meaning. Accordingly, Applicants respectfully request withdrawal of the rejection of Claim 27.

**Claims 51 and 52**

At section 6 of the Office Action, the Office rejected Claims 51 and 52 under U.S.C. § 112, paragraph 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office asserted that “regarding claim 51, it is unclear how the container could be configured to include a third platform,” and “regarding claim 52, it is unclear how the platforms can be provided as separate pieces yet be coupled together as limited by claim 42. Specifically, it is unclear if the pieces are provided as being separate before they are coupled by the hinge assembly.”

Applicants respectfully traverse these rejections. The disclosure provides support for a third platform. See, e.g., paragraph 36 of the specification. From the disclosure, a person skilled in the art would readily recognize: (1) the container may be configured to include a third platform; (2) the platforms may be coupled together as disclosed elsewhere within the Application; (3) the platforms may be provided as separate, non-integrally formed pieces (e.g., the pieces may be separate pieces which are coupled by the hinge assembly); and (4) new FIGURE 8 shows an embodiment of a container with a supplemental platform as described in the specification. See, e.g., paragraph 36 of the specification. However, these are only examples, and the configuration is not intended to be limited in scope by any exemplary embodiment.

Accordingly, Applicants respectfully request that the Office reconsider and withdraw the rejection of Claims 51 and 52 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections – 35 U.S.C. § 102(e)**

At section 8 of the Office Action, the Office rejected Claims 1-18 as being anticipated by U.S. Patent No. 6,178,085 to Leung (“Leung”) under 35 U.S.C. § 102(e). The Office stated Leung “discloses a calculator lid mechanism.” Leung does not identically disclose the combination of elements recited in independent Claim 1. Claim 1 recites a combination including among other elements, a “container for holding a cosmetic,” which is not identically disclosed in Leung.

At section 8 of the Office Action, the Office states that “the initial statement of intended use and all other functional implications have been carefully considered but are deemed not to impose any patentability distinguishing structure over that disclosed by Leung which is capable of being used in the intended manner, i.e., as a compact cosmetic case.” In addition, the Office states that “one could provide some makeup underneath lid (18).”

Applicant respectfully traverses this contention. According to the courts, a preamble recitation will be construed as a limitation if it breathes life, meaning, and vitality into the claim. See Porter v. Farmers Supply Serv., Inc., 790 F.2d 882, 885 (Fed. Cir. 1986); see also Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896 (Fed. Cir. 1984) (describing how “those limitations appear in the preamble, but are necessary to give meaning to the claim and properly define the invention”). Further, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251 (Fed. Cir. 1989) (explaining that the determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the Application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”).

In light of the specification, Claim 1 teaches a “container for holding a cosmetic.” Leung does not disclose how the “calculator lid mechanism” could be used as a “container for holding a cosmetic.” The assertion made by the Office that the structure disclosed by Leung “is capable of being used as a compact cosmetic case” is incorrectly applied to a 35 U.S.C. § 102(e) rejection since there is no teaching of this capability anywhere in Leung. It is well established that for anticipation, a reference must teach every aspect of the claim. Accordingly, Claim 1 (and corresponding dependent Claims 2-18) are not anticipated by Leung under 35 U.S.C. § 102(e) and are patentable.

**Claim Rejections – 35 U.S.C. § 103(a)**

At section 10 of the Office Action, the Office rejected Claims 19-31, 37-50, 52-54 and 58-65 as being unpatentable over U.S. Patent No. 6,178,085 to Leung (“Leung”) under 35 U.S.C. § 103(a). Claims 20-31, 38-41, 43-50, 52-54, and 59-65 depend from independent Claims 19, 37, 42, and 58. Claims 19, 37, 42, and 58 recite a combination including, among other elements, a “container for holding a cosmetic.”

Leung discloses a “calculator lid mechanism.” The subject matter recited in Claims 19, 37, 42, and 58 would not have been obvious in view of Leung under 35 U.S.C. § 103(a). The “container for holding a cosmetic” as recited in Claims 19, 37, 42, and 58, is not disclosed, taught or suggested by Leung. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As understood by the courts, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). “The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.”

Leung does not provide any motivation or suggestion to modify the “calculator lid mechanism” to meet the terms of the claims. For example, Leung does not provide any motivation or suggestion to provide a cosmetic with the “calculator lid mechanism.” Further, as stated on page 8 of the Office Action, Leung “does not disclose pivoting the cover at a rate of about 60 to 120 degrees per second” as recited in Claims 19, 37, 47 and 63. Without a showing of a disclosure, motivation or suggestion in the art that teaches the claimed pivoting velocity, the Office has not established a prima facie case that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a specific angular velocity at which the case opens. To transform the “calculator lid mechanism” of Leung to the “container for holding a cosmetic” recited in independent Claims 19, 37, 42, and 58 would require modifications taught only by the Applicants’ own disclosure.

Further, Leung is nonanalogous art. As MPEP § 2141.01(a) describes, “in order to rely on a reference as a basis for rejection,” the reference must either “be in the field of applicant’s endeavor, or if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” See In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992). There are many reasons why Leung is not considered to be in the field of the Applicants’ endeavor. For example, a cosmetic container is a relatively simple, non-electrical product whereas a calculator is a complex, electronic component including circuits, keys, and a display screen. Further, the purpose of a cosmetic container is completely different from the purpose of a calculator. A cosmetic container is generally intended to contain or hold makeup, whereas a calculator is intended to assist a user in solving complicated mathematical problems and scientific equations. Further, the manufacturers of cosmetic containers and calculators are in different channels of commerce because each product is unrelated to the other. Consequently, cosmetic containers and calculators are not in direct competition in the marketplace. Due to the extreme differences between calculators and cosmetic containers, (1) it is not economically feasible for manufacturers to invest in research and development of both products, and (2) manufacturers in each field do not look to art in the other field to develop new ideas and innovations. Accordingly, Leung is not in the field of the Applicants’ endeavor.

In addition, the calculator of Leung is not reasonably pertinent to the problems addressed by the cosmetic container recited in Claims 19, 37, 42 and 58. For example, Leung teaches the use of a platform that “alternatively form[s] a cover for a display panel and a stand for the calculator.” See col. 2, lines 64-65. This problem is not pertinent to the problems addressed in the present Application. The present Application addresses the problem of providing a hands free cosmetic container where “activation of a user interface automatically positions the cover to a viewing position relative to the base of the container.” See paragraph [005]. Thus, the problem of Leung teaches away from the cosmetic container recited in Claims 19, 37, 42 and 58.

Leung also does not appreciate the significant advantages of a cosmetic container having a lid that operates according to the claims. Such a lid prevents components, such as makeup or



applicator brushes, from falling out of a cosmetic case. The calculator of Leung does not include loose parts under the cover of the calculator that are susceptible to falling out of the device when the cover is opened. Moreover, any loose materials would fall out of the calculator of Leung when opened because it would be at an angle relative to the horizontal. Conversely, Applicants' cosmetic container includes a cosmetic and/or an applicator that could potentially fall from the container if at an angle. Thus, unlike the calculator of Leung, the container for holding a cosmetic as recited in Claims 19, 37, 42 and 58 provides a hands free opening device that minimizes the risk of components falling loose when opening the container.

Furthermore, with respect to Claims 51, 56 and 57, Leung does not teach or suggest the use of a third platform to obtain an open configuration. In fact, Leung teaches away from the use of a third platform since Leung focuses on providing a lid that acts as a stand and a cover. In contrast, the "container for holding a cosmetic" can incorporate the use of a third platform to support the cover and the base. Thus, Leung is not pertinent to the present Application with respect to additional platforms (e.g., a supplemental or third platform).

Accordingly, the calculator of Leung is not analogous to cosmetic containers, and Leung may not be used alone, or in any proper combination with other references to show that the "container for holding a cosmetic" recited in Claims 19, 37, 42, and 58 is obvious under 35 U.S.C. § 103(a).

Thus, the subject matter recited in Claims 19, 37, 42, and 58 would not have been obvious over Leung under 35 U.S.C. § 103(a). Claims 20-31, 38-41, 43-50, 52-54 and 59-65 depend from Claims 19, 37, 42, and 58.

Applicants' respectfully request allowance of Claims 19-31, 37-50, 52-54 and 58-65.

\* \* \*

After amending the claims as set forth above, Claims 1-31, 37-65, and 75-88 are now pending in this Application. No new matter has been added. The Applicants submit that each

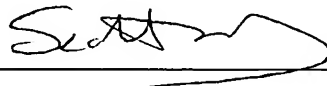
and every outstanding rejection to the pending claims has been overcome, and the Application is now in condition for allowance. Favorable reconsideration of the Application as amended is respectfully requested.

The Office is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present Application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this Application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 11/3/03

By 

FOLEY & LARDNER  
Suite 3800  
777 East Wisconsin Avenue  
Milwaukee, Wisconsin 53202-5306  
Telephone: (414) 297-5872  
Facsimile: (414) 297-4900

Scott M. Day  
Attorney for Applicant  
Registration No. 52,801